

REMARKS

Claims 1-16 are pending in this application, of which claim 1 is independent. Applicants acknowledge, with appreciation, the Examiner's indication that claims 1-16 would be allowable if the double patenting rejections discussed below were overcome. Applicants submit that by the present Remarks, this application is placed in clear condition for immediate allowance.

Doubling Patenting

1. Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-9 of copending Application No. 10/522,176 (" '176 application).

In paragraph 8 of the Office Action, the Examiner asserted, "[t]he subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows (related subject matter shown as **bold**):..." (emphasis in original).

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is -- does any claim in the application define an invention that is anticipated by, or is merely an obvious variation of, an invention claimed in the patent? *See Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434 (Bd. Pat. App. & Inter. 2000). It is apparent from the Examiner's comments in paragraph 8 of the Office Action that claim 1 of the present application does not read on claim 1 of the '176 application because the subject matter described in claim 1 of the '176 application is not essentially identical to claim 1 of the present application.

A double patenting rejection of the obviousness-type, if not based on an anticipation rationale, is analogous to the nonobviousness requirement of 35 U.S.C. §103 except that the

patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Legal precedent is well developed on the subject of obviousness in the application of a rejection under 35 U.S.C. § 103. It is incumbent upon the examiner to factually support a conclusion of obviousness. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The examiner must provide a reason why one having ordinary skill in the art would have been led to modify a particular prior art reference in a particular manner to arrive at a particular claimed invention; *Ecolchem Inc. v. Southern California Edison, Co.* 227 F.3d 361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Applicants submit that, as already argued in the August 1, 2008 response, claim 1 of the present application is not an obvious variation of the claims of the '176 application at least because the claim of the '176 application does not disclose or suggest, among other things, the following limitations recited in claim 1 of the present application:

said first storage portion further stores a flag, corresponding to said classified data, indicating whether said classified data can be used or not, and

said control portion determines the state of storage of said classified data to be input/output in said first storage portion according to comparison of an identification code of classified data stored at a storage position in said first

storage portion specified by said address with an identification code stored in said second storage portion, and a state of said flag corresponding to said classified data to be input/output.

The Examiner did not provide any factual basis as to why the above-recited limitations are taught in the claims of the '176 application, and hence they are not taught by any claims of the '176 application. Applicants respectfully request the Examiner to respond why the above-recited limitations are taught by the claims of the '176 application, otherwise the double patenting rejection of the claims should be withdrawn.

Based on the foregoing, Applicants respectfully solicit withdrawal of the double patenting rejection of claims 1-16 and favorable consideration thereof.

2. Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-15 of copending Application No. 10/340,832.

The Examiner also maintained the nonstatutory double patenting rejection of claims 1-16 over claims 1-15 of copending Application No 10/340,832 ('832 application).

Applicants submit that, as already argued in the August 1, 2008 response, claim 1 of the present application is not an obvious variation of the claims of the '832 application at least because the claim of the '832 application does not disclose or suggest, among other things, the following limitations recited in claim 1 of the present application:

said first storage portion further stores a flag, corresponding to said classified data, indicating whether said classified data can be used or not, and

said control portion determines the state of storage of said classified data to be input/output in said first storage portion according to comparison of an identification code of classified data stored at a storage position in said first storage portion specified by said address with an identification code stored in said second storage portion, and a state of said flag corresponding to said classified data to be input/output.

The Examiner did not provide any factual basis as to why the above-recited limitations are taught in the claims of the '832 application, and hence they are not taught by any claims of the '832 application. Applicants respectfully request the Examiner to respond why the above-recited limitations are taught by the claims of the '832 application, otherwise the double patenting rejection of the claims should be withdrawn.

Based on the foregoing, Applicants respectfully solicit withdrawal of the double patenting rejection of claims 1-16 and favorable consideration thereof.

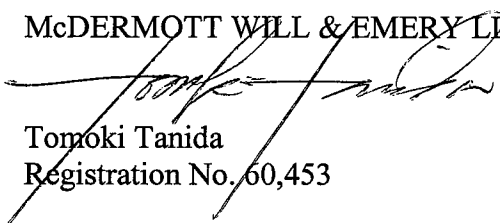
Conclusion

In view of the above remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Response or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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